

REMARKS

Responsive to the Office Action mailed on December 1, 2006 in the above-referenced application, Applicant respectfully requests amendment of the above-identified application in the manner identified above and that the patent be granted in view of the arguments presented. No new matter has been added by this amendment.

Present Status of Application

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi (US 2002/0173281) in view of Matsumura et al (US 5,652,766, hereinafter "Matsumura").

In this paper, claim 1 and the specification are amended to correct informalities. Support for the amendments can be found at least on page 7, lines 27-29, page 8, lines 27-30 and Figs. 3a-3c of the application. New claim 17 is added. Support for the new claim can be found throughout the original disclosure. Thus, on entry of this amendment, claims 1-17 remain in the application.

Reconsideration of this application is respectfully requested in light of the amendments and the remarks contained below.

Rejections Under 35 U.S.C. 103(a)

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi in view of Matsumura. Applicant respectfully traverses the rejections for the reasons as discussed below.

MPEP 2142 reads in part:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the

claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In connection with the third criteria, MPEP 2143.03 goes on the state:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Claim 1 recites a folding electronic device comprising a body, an upper housing portion, a transmitting member, a first elastic member, and a sliding member. The upper housing portion is disposed on the body in a manner such that the upper housing portion rotates between a closed position and an open position. The transmitting member is disposed between the body and the upper housing portion in a manner such that the transmitting member rotates between a first position and a second position. The upper housing portion rotates along with the transmitting member. The first elastic member is disposed between the transmitting member and the body so as to rotate the transmitting member to the second position. The sliding member is disposed in the body in a manner such that the sliding member is slidable between a third position and a fourth position so as to rotate the transmitting member. The sliding member is engaged with the transmitting member located in the first position when the sliding member is located in the third position. The sliding member is disengaged from the transmitting member so that the transmitting member rotates to the second position by the first elastic member and the upper housing portion rotates to the open position from the closed position when the sliding member is moved to the fourth position from the third position.

Kobayashi discloses a folding portable telephone comprising a first housing 11, a second housing 12, and a hinge portion 13. A second hinge unit 15 is formed on the other end of the hinge portion 13. The second hinge unit 15 comprises a second fixed tube 42 and a screwed

coil spring 43. The second fixed tube 42 is composed of a tubular portion 42c. The screwed coil spring 43 is contained in the tubular portion 42c, as illustrated in FIG. 6.

In the office action, the Examiner identifies the screwed coil spring 43, hinge portion 13, and the folding portable telephone as the alleged first elastic member, transmitting member and body of claim 1. However, in Kobayashi, the screwed coil spring 43 is contained in the tubular portion 42c of the second fixed tube 42 of the second hinge unit 15 formed on the other end of the hinge portion 13. It is not disposed between the alleged "transmitting member" 13 and "body" of the telephone. Thus, contrary to the assertion of the Examiner, there is no teaching in Kobayashi that the first elastic member is disposed between the transmitting member and the body so as to rotate the transmitting member to the second position, as recited in claim 1. Matsumura is also silent with respect to this limitation.

Furthermore, the Examiner relies on the opening and closing operating key 4 of Matsumura to teach the sliding member of claim 1. However, Matsumura merely discloses a portable compact disc player composed of a compact disc player body 2, wherein a key 4 is slid to unlock the cover from the body so that the cover may open. There is no teaching or suggestion in Matsumura that key 4 is disposed in the body in a manner such that the sliding member moves between a third position and a fourth position so as to rotate a transmitting member, as recited in claim 1.

In addition, there is no teaching or suggestion in Matsumura that key 4 is engaged with a transmitting member located in a first position when key 4 is located in a third position, and key 4 is disengaged from the transmitting member so that the transmitting member rotates to a second position by a first elastic member and an upper housing portion rotates to an open position from a closed position when key 4 is moved to a fourth position from the third position. Kobayashi is also silent with respect to these limitations. Furthermore, if key 4 were added to Kobayashi device, it is unclear how it could possibly be combined with hinge portion 13 (i.e., the alleged "transmitting member") without fundamentally changing the principle of operation of the Kobayashi device and essentially redesigning both hinge 13 and key 4 based on the template of claim 1. In this regard, the Examiner is reminded that it is impermissible to use the claimed

invention as an instruction manual or "template" to piece together the teachings of the prior so that the claimed invention is rendered obvious. *In re Gorman*, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). It is the Applicant's belief that the present rejection fits the Federal Circuit's description of an impermissible rejection under §103. The Examiner has simply listed certain elements of the present invention and then located isolated disclosures of those components.

It is therefore Applicant's belief that even when taken in combination, the prior art references relied upon by the Examiner do not teach or suggest all the limitations of claim 1. For at least this reason, a *prima facie* case of obviousness cannot be established in connection with these claims. Furthermore, as it is Applicant's belief that a *prima facie* case of obviousness is not established for claim 1, the Examiner's arguments in regard to the dependent claims are considered moot and are not addressed here. Allowance of claims 1-16 is respectfully requested.

New Claim 17

New claim recites, *inter alia*, a folding electronic device comprising an arrangement of a sliding member and transmitting member in which 1) the sliding member is engaged with the transmitting member when the transmitting member is located in the first position while the sliding member is located in the third position, 2) the movement of the sliding member from the third position to the fourth position presses the transmitting member to rotate from the first position to an intermediate position between the first position and the second position, and 3) the sliding member is disengaged from the transmitting member when the sliding member reaches the fourth position such that the transmitting member is rotated from the intermediate position to the second position by the first elastic member. Applicant submits that whether taken alone or in combination, the cited art fails to teach or suggest these limitations.

Conclusion

The Applicant believes that the application is now in condition for allowance and respectfully requests so. The Commissioner is authorized to charge any additional fees that may be required or credit overpayment to Deposit Account No. **502447**. In particular, if this response is

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not timely filed, then the commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 C.F.R. § 1.136(a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to Deposit Account No. **502447**.

Respectfully submitted,

/Nelson A. Quintero/

Nelson A. Quintero

Reg. No. 52,143

Customer No. 34,283

Telephone: (310) 909-8535

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